

REMARKS

1. Interview Summary and Applicants' Amendments

Applicants thank Examiner Bui for the courtesies extended during a telephone interview for reducing the number of issues and providing clarification of the present Office Action.

Claim 95 has been amended to correct informalities. The Examiner has indicated that claims 101 and 102 are allowable, if the claims are rewritten in independent form to include all the limitations of the base claim and any intervening claim. Claim 101 has been canceled and its subject matter incorporated into amended claim 95. Claim 95 and dependent claims 96-105, 118-119 and 125 that further limit claim 95 are now considered allowable according to the Examiner's instructions.

2. §102 Rejection of Claims over Von Oepen

Claims 1-6, 9-11, 21, 23-25, 28-33, and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by Von Oepen (WO 98/35634). The Examiner has stated that Von Oepen, as presented on page 3 of the present Office action, substantially discloses all the limitations recited in the above claims. Applicants respectfully disagree with this rejection.

Von Oepen does not teach or suggest a stent having loop containing sections wherein at least one of the legs in any one of the loop containing sections is shorter than at least one other leg in the same loop containing section within a triangular cell. Furthermore, the loop containing sections of Von Oepen are not oriented along the longitudinal axis.

In fact, Von Oepen teaches away from such an arrangement by disclosing legs and loops oriented in the radial or circumferential direction. As stated in applicants' previous response filed February 11, 2005, a loop contains two adjacent legs. Clearly, the 2nd loop as noted by the Examiner on page 3 of the present Office action and the 2nd loop's adjacent legs are oriented in the circumferential direction and not the longitudinal direction as the instant claim. There is no teaching or suggestion in Von Oepen to have the 2nd loop's adjacent legs oriented as the pending claims.

Applicants respectfully submit that for the claims to be anticipated by a reference in terms of 35 U.S.C. §102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference and arranged as in the claims under review. Since every element of the claimed invention is not identically shown and arranged as in Von Oepen, reconsideration and withdrawal of the rejection is respectfully requested.

3. §102 Rejection of Claims over Berry

Claims 21-22, 108-109 and 122 are rejected under 35 U.S.C. §102(e) as being anticipated by Berry (US 6, 231,598). Applicants respectfully disagree with this rejection.

Berry does not teach or suggest a loop containing section having legs, wherein at least one of the legs of the loop containing section is shorter than at least one other leg in the same loop containing section within the triangular cell. Further, the loop containing sections of Berry are not oriented in the longitudinal direction. The shorter member identified by the Examiner in Berry in the previous Office Action dated February 6, 2004 is not oriented in the longitudinal axis of the stent. In fact, the shorter member identified by the Examiner is in the circumferential direction. Berry merely describes an "interconnection strut" in the circumferential direction that attaches a longitudinal strut (15) to a curvilinear strut of interconnection segment (21). (See Berry, Figs, 1, 5, and 8 and Col. 11, lines 55-65).

In addition, the shorter member identified by the Examiner is not a short leg as claimed. There can be no flexibility in the shorter member in Berry due to the longitudinal struts (15, 16) that maintain its longitudinal rigidity, during and after stent expansion (See Berry, Col, 9, lines 24-30).

Applicants respectfully request favorable reconsideration of the claims in view of the above remarks. Withdrawal of the rejection applied to the above claims in view of Berry under 35 U.S.C. §102 is respectfully requested.

4. §103 Rejection of Claims in view of Von Oepen and Official Notice

Claim 20 is rejected under 35 U.S.C. §103 as being unpatentable over Von Oepen in view of Official Notice. The Examiner contends that Von Oepen discloses substantially all structural limitations of the present invention except for plating the stent with a radiopaque material/protective material/medicine. The Examiner further states it is well known in the art to coat a stent with such material and it would have been obvious to one skilled in the art to provide the stent disclosed in Von Oepen with such a coating.

Applicants respectfully traverse the rejection and contend that a *prima facie* case of obvious has not been made. Applicants repeat the remarks as discussed above, and reiterate that the claimed features are not taught or suggested in Von Oepen.

The mere fact that a structure described in a reference could be modified to produce the claimed invention does not make the modification obvious unless the reference suggested the desirability of the modification In re Fritch, 23 U.S. P. Q. 1780, 1783 (Fed. Cir. 1992); In re Gordon, 21 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Since Von Oepen does not teach or suggest this concept reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

5. §103 Rejection of Claims over Brown in view of Von Oepen

Claims 95-100, 104-105, 108-111, 113-114, 116-119, 122, and 125 have been rejected under 35 U.S.C. §103 as being unpatentable over Brown (US 6, 776,793) in view of Von Oepen (WO 98/35634). The Examiner identified claims 101-102 as allowable subject matter. Claim 95 was amended to incorporate the limitations of claim 101. The above rejection regarding claim 95 and dependent claims 96-105, 118-119 and 125 is believed to be moot.

Regarding claims 108-111, 113-114, 116-117, and 122, applicants respectfully traverse the rejection and contend a *prima facie* case of obviousness has not been made.

The Examiner stated that Brown discloses substantially all limitations as recited in the applicants' claims, except for the 1st loop containing section having wider legs

than the 2nd and 3rd loop containing sections. The Examiner further stated Von Oepen discloses a stent with bands having wider legs alternating with bands having narrow legs to provide flexibility for the stent. The Examiner concludes that it would have been obvious at the time the invention to make the stent in Brown to have legs wider and narrower as disclosed in Von Oepen.

As described in the Summary of Invention, Brown discloses providing a flexible stent by using different wavelengths over the length of the stent and/or disposing the interconnecting members in such a way that after expansion of the stent, the phase relationship between adjacent bands is altered with the peaks and troughs displaced circumferentially relative to each other.

Brown teaches away from using diamond cell shape stents stating in its Background Section:

A diamond configuration with diagonal connections between each and every diamond of each segment is also known but such closed configurations lack flexibility. It is an object of this invention to provide a longitudinally flexible stent of open configuration that avoids these problems and exhibits improved flexibility (radially and longitudinally) in the stent body segments thereof rather than in flexible joints between the segments.

Von Oepen, on the other hand, discloses the use of diamond cells having at least one spring element provided per cell. These "spring elements" are denoted in the present Office action by the Examiner as 2nd and 3rd loop containing sections having narrower legs to enhance flexibility of the stent. Von Oepen further states in the Summary of Invention:

The spring element can for instance be a U- or V-shaped loop in one of the webs or legs of each cell. Hence, it is possible with the invention to form a multicellular stent which comprises a plurality of e.g. diamond-like cells or at least cells that resemble diamonds. The legs or webs which surround the cells or diamonds may here comprise the spring elements which in the non-spread state permit sufficient flexibility across the longitudinal axis.

One skilled in the art would not use the disclosure of Brown that discourages the use of diamond cell structures in combination with the disclosure of Von Oepen that uses diamond cell structures. There is no motivation or suggestion to combine the disclosure of Brown with Von Oepen as the Examiner has suggested. In fact, Brown teaches away from using the structure in Von Oepen as previously stated.

An Examiner cannot merely point to the disclosure of certain individual claim elements in each reference and then, without more, conclude that it would have been obvious to one of ordinary skill to combine these references. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obviousness was held to be improper). In addition, "the level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01 at p. 2100-98.

None of the references cited either individually or in combination discloses a stent as the applicants' claim. Applicants contend that since the cited references do not teach or suggest what the applicants claim, the invention clearly cannot have been obvious over the references of record. Reconsideration and withdrawal of the rejection under §103(a) is respectfully requested.

CONCLUSION

Based on the foregoing amendment and remarks, applicants respectfully submit that the claims as currently presented are patentable and in condition for allowance.

If any issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.


Favorable consideration is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4303-4003US1. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: August 15, 2005

By: 
Keith J. McWha
Registration No. 44, 235

Correspondence Address
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 758-4800
(212) 751-6849 (facsimile)